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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/690,173	10/16/2000	Karen W. Shannon	10990638-1	2834

7590 07/26/2002

IP Administration
Legal Department 20BN
Hewlett-Packard Company
P.O. Box 10301
Palo Alto, CA 94303-0890

EXAMINER	
EPPS, JANET L	

ART UNIT	PAPER NUMBER
1635	

DATE MAILED: 07/26/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No.	Applicant(s)	
	09/690,173	SHANNON, KAREN W.	
	Examiner	Art Unit	
	Janet L Epps, Ph.D.	1635	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 July 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☐ The period for reply expires _____months from the mailing date of the final rejection.

b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☒ The proposed amendment(s) will not be entered because:

   (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ they raise the issue of new matter (see Note below);

   (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☒ they present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: *See Continuation Sheet*.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☐ The a)☐ affidavit, b)☐ exhibit, or c)☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a)☒ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: *32-48 for the reasons of record sef forth in the Office Action mailed 5-08-2002*.

   Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10. ☒ Other: *see attached*

Continuation of 2. NOTE: Applicants have added new claims 49-51, these claims recite limitations that were not presented in the claims prior to the Final Office Action mailed 5-08-2002. .

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Response to Arguments

2. Claims 32-37 and 39-40 remain rejected and claims 38, and 41-48 are under 35 U.S.C. 102(e) as being anticipated by Wang et al, and claims 32-36 and 39-40 remain rejected under 35 U.S.C. 102(b) as being anticipated by Phillips et al. for the reasons of record set forth in the Official Action mailed 5-08-2002.

Applicant's arguments filed 7-09-02 have been fully considered but they are not persuasive. Applicants traverse the instant rejections on the grounds that elements containing printed material do have patentable weight and cannot simply be removed from a claim before a claim is examined. Applicants cite *In re Lowry* to support their assertion that the printed material instantly claimed constitutes a limitation upon which patentability may be predicated.

However, contrary to Applicant's assertions, the facts upon which the Lowry case was decided are not applicable to the instant invention. For example, the printed matter of the Lowry invention is manipulated by a computer and organized into a particular data structure. Furthermore, the Lowry invention, as defined by the claims, required that the information (regarded as printed matter) be processed not by the mind but by a machine, a computer. In the instant case, the printed matter provides an "intended use" of the contents of the claimed kit. The printed matter is not processed by the contents of the kit as in the case of *In re Lowry*, therefore the decision set forth regarding the invention of *In re Lowry* can not be applied in the

instant case since the facts of *In re Lowry* are not coextensive with those facts regarding the instantly claimed invention.

Applicants further argue that any method suggested by the references of Wang or Phillip is different from the method recited in the claimed kits, as such Applicants argue that these references do not anticipate the claimed invention. However, it is noted that Applicants have not explicitly stated how the method suggested by either Wang or Phillip is distinct from the intended use of the kit of the claimed invention. As stated in the prior Office Action, Wang et al. provides kits for use in a method for mRNA amplification, where such kits may comprise containers, each with one or more of the various reagents (typically in concentrated form) utilized in the methods, including, for example, buffers, the appropriate nucleotide triphosphates, reverse transcriptase (preferably M-MLV RT lacking RNAseH activity), DNA polymerase (HTLV-1, HIV, BLV, Taq and Tth), RNA polymerase (e.g. T7), one or more primer complexes of the present invention (e.g., poly(T) or random primers linked to a promoter reactive with the RNA polymerase), and a set of instructions will also typically be included.

Additionally, Phillips et al. discloses compositions for the intended use of linear amplification of mRNA comprising the use of the contents of the kit recited in the instant claims particularly wherein said kit comprises: an oligonucleotide comprising an RNA polymerase promoter sequence, at least one polymerase, further comprising an RNA polymerase (e.g., T7).

Moreover, as stated in the prior Office Action, the instructions merely provide an intended use of the remaining contents of the kit, which requires manipulation of the contents of the kit. The kit absent the manipulations directed by these instructions is clearly anticipated by

the prior art. Applicant's arguments do not take the place of evidence clearly distinguishing the claimed invention from the prior art.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet L Epps, Ph.D. whose telephone number is 703-308-8883. The examiner can normally be reached on M-T, Thurs-Friday 8:30AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John LeGuyader can be reached on (703)-308-0447. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-746-5143 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Janet L Epps, Ph.D.
Examiner
Art Unit 1635

JLE
July 25, 2002

SEAN McGARRY
PRIMARY EXAMINER